

## **REMARKS**

**The Examiner advised that the application lacks the necessary reference to the prior application.** In response, Applicant has inserted a reference to the prior application into the first page of the specification.

**The Examiner rejected claims 1-12 under 35 U.S.C. 102(b) as being anticipated by Ooi (U.S. Patent No. 5,026,028).** In particular, the Examiner stated that Ooi discloses (Fig. 1) a rail clip for attaching a rail to a post, the rail clip comprising a bracket (2) adapted to be mounted on the post (1); a rail connector (20), and a connector mechanism (4, 5, 12, 16, 22, 26) for securing the rail connector and bracket together. **In response**, Applicant has amended claims 1, 2, 4, 5 and 9 to more clearly define Applicant's invention. In response to the rejection specifically, Applicant respectfully submits that the component identified in Ooi as 20, does not and cannot function as a rail connector as disclosed and claimed by Applicant. The applicant submits that Ooi's component 20 is merely a cover for protecting the connection between the strut 1, and horizontal member 10. Furthermore, Applicant submits that cover 20 could be entirely omitted from the apparatus and there would be no detrimental effect on the functioning of the apparatus. Applicant's position is supported in the reference's description of cover 20 in column 3, lines 34-41. In this passage one learns that the cover is fitted over the horizontal member 10 from above. From column 3, lines 44-47, one learns that the cover is manufactured from an elastic material and is made to elastically deform. One can therefore surmise that the cover 20 snap-fits

around horizontal member 10. This is supported by Fig. 4 of the patent where it can be seen that the sides 22 of cover 20 lie laterally outwardly of the heads of screws 16 and are in fact deformed outwardly by the screws 16. If cover 20 was omitted from the apparatus, strut 1 would still be connected to horizontal member 10. Furthermore, Applicant submits that there is no indication, in either the description or drawings of Ooi, that the connector mechanism specified by the Examiner, namely components 4, 5, 12, 16, 22 and 26, secure the rail connector "20" to the bracket 2. Applicant respectfully submits that, in fact, the component in Ooi which is secured to the bracket 2 by a connector mechanism, (16) is horizontal member bracket 12 and not cover 20 (see also column 3, lines 6-11 where it is stated : "The horizontal member 10 has a longitudinally extending downward recess 1 defined by the lower wall 10a, and is connected through the intermediary of a horizontal member bracket 12 to the above mentioned strut bracket 2 in such a way as to be turned freely up and down relative to the latter."

Applicant therefore respectfully submits that the limitations of claim 1 should be examined with reference to the horizontal member bracket 12 and not to the cover 20. Claim 1 of the instant application requires that the rail connector be connected to the bracket by way of a first connector mechanism and a second connector mechanism. The first connector mechanism allows for arcuate adjustment of the rail connector and bracket relative to each other. The second connector mechanism locks the relative positions of the rail connector and brackets so that no additional arcuate adjustment can occur. Applicant submits that Ooi does disclose a first connector mechanism for

connecting the bracket 2 and rail connector 12 to each other. This first connector mechanism consists of screws 16. These screws 16 allow for connection of the rail connector 12 and bracket 2 in such a manner that the rail connector 12 and bracket 2 can be arcuately adjusted relative to each other. Applicant submits, however, that there is no second mechanism provided for securing the rail connector 12 and bracket 2 together in such a manner that the relative positions of the two components are locked together so that no additional relative movement can occur between the two components as is required in the claims. In Applicant's device, the first connector mechanism is the interlocking rail connector and bracket. This first connector allows the rail connector and bracket to be arcuately adjusted relative to each other but does not allow axial or lateral withdrawal of the rail connector from the bracket. The second connector mechanism in the Applicant's device is a fastener means, such as screws (62) which are inserted through aligned holes 60 and 84. These screws prevent any further arcuate motion between the rail connector and the bracket. There is no suggestion of two independent connector mechanisms in Ooi. Even if the cover 20 was considered to be a second mechanism for connecting the bracket 2 and rail connector 12, cover 20 does not prevent further arcuate motion between bracket 2 and rail connector 12 as the cover 20 simply snap-fits over the components and would still allow the components to rotate freely relative to each other. This is supported by column 3, lines 28-40 where it is stated that

*".....even when the horizontal member 10 is turned up or down relative to the strut 1, it is still possible to keep the central cover plate 25 in contact with the mounting plate 3 and keep the side cover plates 26 in contact with the side face 1a of the strut 1 without forming any clearance between*

the strut 1 and the horizontal member , **and the horizontal member 10 can be connected to the strut 1 at any desired angle.** " (emphasis added by Applicant).

Applicant therefore submits that cover 20 cannot even be considered to be a second mechanism for locking the bracket and rail connector together.

According to *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), ***cert. denied***, 482 U.S. 909 (1987)

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. . . . In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.

and in *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984)

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.

Inasmuch as Ooi does not disclose a rail connector having a first mechanism for securing the bracket and rail connector together to initially allow relative axial movement of the two components while preventing axial or lateral withdrawal of the rail connector from the bracket **and** a second connector mechanism for locking the relative positions of rail connector and bracket when they are in the desired orientation relative to each other; Applicant respectfully submits that Ooi does not include each and every element of claim 1 and that this claim is therefore not anticipated by Ooi.

Applicant respectfully submits that, because the interpretation of the cover 20 as being a rail connector is in error, all of the remaining claims, namely claims 2-12

contain limitations which are not possessed by the Ooi's real rail connector, namely horizontal member bracket 12. Applicant therefore submits that consequently none of these claims is anticipated by Ooi. For example, in reference to claim 2 of the instant application, the Examiner stated that Ooi discloses the rail connector slidably engages the bracket and that the position of the rail connector is adjusted by sliding the rail connector relative to the bracket. In response, Applicant submits that this statement may or may not disclose the relationship between the cover 20 and the bracket 2, but, as discussed above, cover 20 is not a rail connector as claimed by the Applicant. The rail connector of Ooi is horizontal member bracket 12 and this component does not slidably engage the outer surface of bracket 2, it rotatably engages the inner surfaces of the side walls 4 of bracket 2. Applicant submits that amended claim 2 defines over the prior art. Again, in reference to claim 3, Applicant submits that component 20 is merely a cover and not a rail connector and that, instead, the horizontal member bracket 12 functions as a rail connector. Horizontal member bracket 12 does not include any grooves or bosses and neither does bracket 2. Consequently, claim 3 distinguishes over the prior art. With reference to claim 4, as discussed previously, there is no second mechanism for locking the relative positions of the rail connector and bracket. The screws 16 are the first mechanism for connecting the horizontal member bracket 12 and bracket 2 together and the screws 16 do not lock the components together against any further arcuate motion.

Applicant submits that for the reasons presented above, claims 1-12 are not anticipated by Ooi. Applicant respectfully requests the reconsideration of claims 1-12 in

light of the amendments and the above-submitted arguments.

Respectfully submitted at Canton, Ohio this 21 day of June, 2004.

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